

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-53 are currently pending. Claims 1-3, 10-15, 18, 20, 23-25, 32-37, 40, 42, and 45-53 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1-4, 8-10, 12-15, 23-26, 31, 32, 34-37, 45, 46, 48, and 50-52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,219,694 to Lazaridas et al. (hereinafter “the ‘694 patent”) in view of U.S. Patent No. 5,412,779 to Motoyama (hereinafter “the ‘779 patent”); Claims 5-7, 11, 16, 17, 27-29, 30, 33, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘694 and ‘779 patents, further in view of U.S. Patent No. 5,951,636 to Zerber (hereinafter “the ‘636 patent”); Claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘694 and ‘779 patents, further in view of U.S. Patent No. 6,108,492 to Miyachi (hereinafter “the ‘492 patent”); Claims 18 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,065,136 to Kuwabara (hereinafter “the ‘136 patent”) in view of the ‘779 patent; Claims 19-22 and 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘136 and ‘779 patents, further in view of the ‘694 patent; and Claims 49 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the ‘136 and ‘779 patents, further in view of the ‘492 patent.

Amended Claim 1 is directed to a method of processing messages, comprising:
(1) receiving an electronic mail message by a computer; (2) determining, by the computer, whether a content of the received message is for the user or relates to monitoring or control of an attached printing device associated with the computer by detecting a characteristic of the message, the attached printing device including a processor; (3) transmitting a

communication from the computer to the attached printing device, if the determining step determines that the received message relates to monitoring or control of the attached printing device; and (4) operating the processor of the attached printing device in response to the transmitted communication. Claim 1 has been amended for the purposes of clarification only and no new matter has been added.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '694 patent discloses everything in Claim 1 with the exception of "control of [an] attached image printing device (copier engine) associated with the computer (user); and transmitting a communication from the computer (user) to the attached image printing device (copier engine)," and relies on the '779 patent to remedy those deficiencies.

The '694 patent is directed to a system and method for pushing information from a host system to a mobile communication device having a shared electronic address with the host system. As shown in Figure 1, the '694 patent discloses a system in which certain user-defined event triggers are activated and messages or commands are redirected from a desktop computer to a mobile communications device. In particular, as shown in Figure 4, regarding incoming email messages, if the messages are to be redirected by the redirector 12, the message is repackaged by placing an outer wrapper around the original message before sending to the mobile device.¹ However, Applicants respectfully submit that the '694 patent fails to disclose the step of determining, by the computer, whether a content of the received message is for a user or relates to monitoring or control of an attached printing device associated with the computer by detecting a characteristic of the message, the attached printing device including a processor, as recited in amended Claim 1. In this regard, Applicants note that the '694 patent fails to disclose an attached printing device. Further, Applicants respectfully submit that the '694 patent fails to disclose a computer that

¹ See, e.g., the '694 patent, column 10, line 39 - column 11, line 5.

determines whether a receive message is for a user or relates to monitoring or control of an attached printing device associated with the computer, as recited in Claim 1. Rather, the '694 patent discloses a system in which all of the messages received by the computer are intended for the user. The '694 system only determines whether or not to forward a message to the user's mobile communication device or to keep the message on the computer. Applicants respectfully submit that such a determination by the '694 patent is unrelated to a determination of whether a received message is for a user or relates to monitoring or control of an attached printing device associated with the computer, as recited in Claim 1. Moreover, Applicants respectfully submit that the deficiency of the '694 patent in this regard cannot be cured by finding a reference that generally discloses the monitoring or control of a printer attached to a computer. Such a combination of references would not teach or suggest a step of determining whether a received message is for a user or relates to monitoring a control of an attached printing device, as recited in Claim 1. Moreover, contrary to the assertion on page 3 of the outstanding Office Action, Applicants respectfully submit that the '694 patent fails to disclose an attached business office device.

In addition, Applicants respectfully submit that the '694 patent fails to disclose the step of transmitting a communication from the computer to the attached printing device, if the determining step determines that the received message relates to monitoring or control of the attached printing device, as recited in amended Claim 1. Rather, the '694 patent discloses that a message intended to the same user is forwarded to the mobile communication device upon the occurrence of particular events or the detection of certain criteria within the received message. However, the '694 patent does not disclose or suggest that a received message could relate to the monitoring or control of an attached printing device and that a communication should be sent from the computer if such a condition occurs. The '694 patent is unrelated to the monitoring and or control of attached printing devices.

The '779 patent is directed to a method and apparatus for controlling and communicating with business office devices. As shown in Figure 1, the '779 patent discloses that if the system control process 102 of the copier engine 10 detects an abnormal state it may send a message to the operational panel 20, which displays the message on a display panel. However, Applicants respectfully submit that the '779 patent fails to disclose a step of determining, by the computer, whether a content of the received message for a user or relates to monitoring or control of an attached printing device associated with the computer by detecting the characteristic of the messaged, the attached printing device including a processor, as recited in Claim 1. While the '779 patent discloses a copier engine 10 connected to an operation panel, the '779 patent does not teach or suggest the determining step recited in Claim 1. The '779 patent does not disclose a computer that examines a received message to determine whether the received message is for a user or relates to monitoring or control of an attached printing device associated with the computer. Further, since it does not disclose the determining step recited in Claim 1, Applicants respectfully submit that the '779 patent fails to disclose the transmitting step recited in Claim 1.

Thus, no matter how the teachings of the '694 and '779 patents are combined, the combination does not teach or suggest the determining step recited in amended Claim 1. Accordingly, Applicants respectfully submit that the rejection of Claim 1 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 1.

In the outstanding Office Action, the stated motivation for combining the teachings of the '694 and '779 patent is "in order to diagnose ... troubles in such devices."² However, Applicants respectfully submit that the Office Action is simply stating perceived advantages of Applicants' invention as motivation to combine the cited references, without identifying that, without Applicants' specification, one of ordinary skill in the art would have even

² Office Action dated March 7, 2006, page 5.

thought to address the problem. Such hindsight reconstruction of Applicants' invention cannot be used to establish a *prima facie* case of obviousness. Moreover, as discussed above, the combination of the '694 and '779 patents does not teach or suggest determining by a computer, whether a content of a received message is for a user or relates to monitoring or control of an attached printing device associated with the computer, as recited in Claim 1. In this regard, Applicants note that the Office Action is asserting that because the '694 patent discloses redirection software that may send a user's message to a user's mobile communication device or store the message on the computer, that this is a teaching of determining whether a content of a received message is for a user or relates to a business office device. Next, the Office Action relies on the '779 patent as disclosing "the monitoring or control of an attached printing device." However, Applicants respectfully submit that the '779 patent is unrelated to determining whether a received message is for a user or for a device, while the '694 patent has nothing to do with the monitoring or control of an attached printing device. Accordingly, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated by the '779 patent teaching of an operation panel 20 and the copier engine 10 to modify the '694 patent to include a determination of whether a received message is (a) for a user or (b) relates to monitoring or control of an attached printing device associated with the computer. The '694 patent does not disclose attached printing devices and all of the messages disclosed by the '694 patent are for the user, so that one of ordinary skill in the art would not have been motivated to modify the '694 patent to include a determination of whether the content of a received message is for a user or relates to monitoring or control of an attached printing device. Thus, Applicants respectfully submit that there is no teaching or suggestion in the combination of the '694 and '677 patents of the determining step recited in Claim 1, but that the Office Action is simply engaging in

hindsight reconstruction in an attempt to find references that disclose the words recited in Claim 1.

For the reasons stated above, Applicants respectfully submit that amended Claim 1 (and all similarly rejected dependent claims) patentably defines over any proper combination of the '694 and '779 patents.

Independent Claim 23 recites limitations analogous to the limitations recited in amended Claim 1. Moreover, Claim 23 has been amended in a manner analogous to the amendment to Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that the rejection of Claim 23 (and all similarly rejected dependent claims) is rendered moot by the present amendment to Claim 23.

Regarding the rejection of dependent Claims 5-7, 11, 16, 17, 27-29, 30, 33, 38, 39, and 47 under 35 U.S.C. § 103, Applicants respectfully submit that the '636 and '492 patents fail to remedy the deficiencies of the '694 and '779 patents, as discussed above. Accordingly, for the reasons stated above, Applicants respectfully submit that the rejections of the above-identified dependent claims are rendered moot by the present amendment to independent Claims 1 and 23.

Amended Claim 18 is directed to a method of transmitting, comprising: (1) transmitting state information including at least one of static, semi-static, and dynamic states of a printing device from the printing device to a first computer directly attached to the printing device, the printing device including a processor; (2) processing, automatically without human intervention, the state information by a software component within the first computer; and (3) transmitting, by the first computer, automatically without human intervention, the processed state information over the Internet to a monitoring second computer. The changes to Claim 18 are supported by the originally filed specification and do not add new matter.

The '136 patent is directed to a system for the remote diagnosis of device "troubles" including a trouble diagnosing computer capable of diagnosing troubles which occur in a main part of a device associated with a user. As shown in Figure 1, computers 5, 6, and 7 are connected via the Internet to a provider computer 8, which is connected to a trouble diagnosis computer 4. As shown in Figure 5, a mail setting program saves diagnostic data, which is sent to the provider computer 5 in an e-mail. Further, the '136 patent discloses that, based on the addressee e-mail code in the e-mail, the provider 5 determines whether the e-mail is addressed to the maker's provider computer 8, and transmits the e-mail message to the provider 8 if it is addressed to the provider 8. Further, the '136 patent discloses that:

[w]hen a trouble is discovered in user A's device 1, its operator immediately operates its input means 17 to load a mail setting program onto the program memory 14D and starts it. At the same time, the information stored then in the diagnostic data memory 14D is processed for saving (step S1). As the mail setting program is activated, a menu for necessary operations for setting electronic mail is displayed on the screen of the monitor 16. The operator connects the provider 5 to the computer part C1 with the telephone line T1, say, by clicking a mouse on the menu on the screen of the monitor 16 (step S2). Thereafter, the mail code of the maker is inputted in the address e-mail code column ML1 (shown in Figure 3) from the input means 17 although it is usually already inputted such that the user would not be required to input it. The mail code of user A himself/herself is inputted in the sender's mail code column ML2. Next, a title for the message (such as "trouble"), indicating that this message is about a trouble, is inputted in the title column in all three. The content of each of the entry columns ML1-ML3 is saved in the e-mail memory 14C. Next, the mouse is clicked again on the menu displayed on the screen of the monitor 16 to enter the information stored in the diagnostic data memory 14D as the diagnostic information to be transmitted by electronic mail.³

Thus, Applicants respectfully submit that the '136 patent discloses that a user of the computer C1 must initiate the sending of an e-mail regarding a malfunction in the device 1.

Thus, Applicants respectfully submit that the '136 patent fails to disclose the step of processing, automatically without human intervention, state information by a software component within a first computer, and transmitting, by the first computer, automatically

³ '136 patent, column 4, line 62 to column 5, line 17.

without human intervention, the processed state information over the Internet to a monitored second computer, as recited in Claim 18. Rather, the '136 patent discloses that a user must initiate the sending of the electronic mail over the Internet by the first computer.

As discussed above, the '779 patent is directed to a method and apparatus for controlling and communicating with business office devices. The '779 patent discloses a copier engine 10 connected to an operational panel 20, which displays information to a user on a display screen. However, Applicants respectfully submit that the '779 patent fails to disclose the steps of processing, without human intervention, the state information by a software component within the first computer, and transmitting, by the first computer, automatically without human intervention, the processed state information over the Internet to a monitored second computer, as recited in amended Claim 18. The '779 patent fails to disclose transmitting information over the Internet to a monitoring second computer or the processing of state information automatically without human intervention, as recited in Claim 18.

Thus, no matter how the teachings of the '136 and '779 patents are combined, the combination does not teach or suggest the processing and transmitting steps recited in Claim 18. Accordingly, Applicants respectfully submit that the rejection of Claim 18 is rendered moot by the present amendment to that claim.

Claim 40 recites limitations analogous to the limitations recited in Claim 18. Moreover, Claim 40 has been amended in a manner analogous to the amendment to Claim 18. Accordingly, for the reasons stated above for the patentability of Claim 18, Applicants respectfully submit that the rejection of Claim 40 is rendered moot by the present amendment to that claim.

Regarding the rejections of dependent Claims 19-22, 41-44, 49, and 53 under 37 C.F.R. § 103(a), Applicants respectfully submit that the '636 and '492 patents fail to remedy

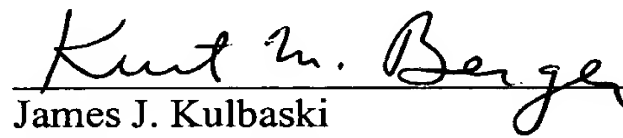
the deficiencies of the '136 and '779 patents, as discussed above. Accordingly, for the reasons stated above for the patentability of Claims 18 and 40 Applicants respectfully submit that the rejections of the above-listed dependent claims are rendered moot by the present amendment to Claims 18 and 40.

Thus, it is respectfully submitted that independent Claims 1, 18, 23, and 40 (and all associated dependent claims) patentably define over any combination of the '694, '779, '136, '492, and '636 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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